

#6

REISSUE LITIGATION
REISSUE PATENT APPLICATION
ATTORNEY DO. NO. 4164-133

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John F. Acres et al.

Serial No. 09/373,034

Patent Reissue Filing Date: August 11, 1999

Title: METHOD FOR OPERATING NETWORKED GAMING DEVICES

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Response to Communication Regarding Prior Art
Citation Under 37 CFR 1.501 dated March 28, 2001

The attached original Information Disclosure Statement submitted in this reissue application on July 28, 2000 has been incorrectly returned. The IDS was submitted for the pending reissue application and not for the issued patent, as indicated in the attached communication dated March 28, 2001.

Applicant requests that the attached IDS be made of record in the pending reissue application.

Any questions about this IDS or the reissue application can be addressed to the undersigned attorney at the phone number below.

Respectfully submitted,



Alan T. McCollom
Registration No. 28,881

MARGER, JOHNSON & McCOLLUM, P.C.
1030 S.W. Morrison Street
Portland, Oregon 97205
(503) 222-3613



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAR 28 2001

Paper No. 15

In re United States Patent
Number: 5,655,961
Patentee: John F. Acres *et al*
Issue Date: October 12, 1994
Attorney Docket No. 4164-1333

: COMMUNICATION REGARDING
: PRIOR ART CITATION
: UNDER 37 CFR 1.501
:

Receipt is acknowledged of the "Information Disclosure Statement" which has recently been associated with the file of the above referenced patent. This paper is treated as a prior art citation pursuant to 35 USC 301 and 37 CFR 1.501.

The citation has been reviewed in detail, and is not considered to be a proper citation under 35 USC 301 and 37 CFR 1.501 because it is not limited to patents and printed publications as required by the statute and regulation. See also MPEP § 2205. Accordingly, the citation is being returned to patent owner as an attachment to this communication, and will not be made of record in the file of the patent. It is noted that no document copies accompanied the filing of this statement.

The patented file is being returned to storage.

Attachment


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Alan T. McCollum
Marger, Johnson, McCollom & Stolowitz
1030 S.W. Morrison Street
Portland, OR 97205

**REISSUE LITIGATION
REISSUE PATENT APPLICATION
ATTORNEY DO. NO. 4164-133**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John F. Acres et al.

Original Patent No.: 5,655,961

Original Patent Issue Date: August 12, 1997

Title: METHOD FOR OPERATING NETWORKED GAMING DEVICES

VIA HAND DELIVERY

Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Pursuant to a telephone conversation between the undersigned attorney and Examiner Harrison in April 2000, all of the documents listed on the attached Form 1449, are not submitted with this IDS.

Rather, due to the large volume, litigation documents and other nonpatent publications, where indicated on the attached Form 1449, are incorporated by reference from copending application no. 08/922,046, filed September 2, 1997, and assigned to the assignee of the present application ('046 application).

Some of the documents incorporated by reference are assembled into Volume IX. Others of the incorporated documents were not bound into separate volumes, but were submitted individually for consideration in the '046 application as indicated on the attached 1449.

The Examiner in the '046 application allowed all of the claims over the information in Volumes I through VIII, which are listed in the IDS submitted when this reissue application was filed, and over the information in this IDS that is incorporated by reference in this IDS from the '046 application.

Accompanying this IDS are copies of all documents in the 1449 that are not incorporated by reference

Applicant requests that the Examiner in this application review the references listed on the Form 1449 attached to this IDS and allow the claims presented in this reissue application. Any questions about this IDS or the reissue application can be addressed to the undersigned attorney at the phone number below.

Respectfully submitted,



Alan T. McCollom
Registration No. 28,881

MARGER, JOHNSON & McCOLLOM, P.C.
1030 S.W. Morrison Street
Portland, Oregon 97205
(503) 222-3613

14

**REISSUE LITIGATION
REISSUE PATENT APPLICATION**

Atty. Docket No.: 4164-133
Applicant: John F. Acres et al.

Original Patent No.: 5,655,961
Original Patent Issue Date: August 12, 1997

**INFORMATION DISCLOSURE CITATION
FORM PTO-1449 (Modified)**

U.S. PATENT DOCUMENTS

<u>Exam Init</u>	<u>Ref</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>	<u>Class</u>	<u>Sub- Class</u>
		3,598,964	8/10/71	Dell	235	61.6 R
		4,230,265	10/28/80	Casaly	235	455
		4,258,838	3/31/81	Rockola et al.	194	1 R
		4,283,709	8/11/81	Lucero et al.	340	147 R
		4,335,809	6/22/82	Wain	194	1 R
		4,467,424	8/21/84	Hedges et al.	364	412
		4,575,622	3/11/86	Pellegrini	235	382
		4,636,951	1/13/87	Harlick	364	412
		4,652,998	3/24/87	Koza et al.	364	412
		4,669,596	6/2/87	Capers et al.	194	210
		4,669,730	6/2/87	Small	273	138
		4,679,143	7/7/87	Hagiwara	364	412
		4,764,666	8/16/88	Bergeron	235	380
		4,775,937	10/4/88	Bell	364	412
		4,805,907	2/21/89	Hagiwara	273	138
		4,815,741	3/28/89	Small	273	138 A
		4,839,640	6/13/89	Ozer et al.	340	825.31
		4,880,237	11/14/89	Kishishita	273	138 A

<u>Exam</u>	<u>Ref</u>	<u>Document</u> <u>Number</u>	<u>Issue</u> <u>Date</u>	<u>Name</u>	<u>Class</u>	<u>Sub-</u> <u>Class</u>
		4,882,473	11/21/89	Bergeron et al.	235	380
		5,116,055	5/26/92	Tracy	273	138 A
		5,135,224	8/4/92	Yamamoto et al.	273	143 R
		5,197,094	3/23/93	Tillery et al.	379	91
		5,217,224	6/8/93	Sincock	273	138 A
		5,249,800	10/5/93	Hilgendorf et al.	273	138 A
		5,257,179	10/26/93	DeMar	364	410
		5,265,874	11/30/93	Dickinson et al.	273	138A
		5,280,909	1/25/94	Tracy	273	138 A
		5,287,269	2/15/94	Dorrough et al.	364	408
		5,326,104	7/5/94	Pease et al.	273	138 A
		5,344,144	9/6/94	Canon	273	138 A
		5,345,379	9/6/94	Brous et al.	364	146
		5,370,306	12/6/94	Schulze et al.	273	138 A
		5,371,345	12/6/94	LeStrange et al.	235	380
		5,429,361	7/4/95	Raven et al.	273	138 A
		5,470,079	11/28/95	LeStrange et al.	273	138 A
		5,473,144	12/5/95	Mathurin, Jr.	235	380
		5,477,040	12/19/95	Lalonde	235	380
		5,494,287	2/27/96	Manz	273	143 R
		5,533,727	7/9/96	DeMar	463	23
		5,559,312	9/24/96	Lucero	235	380
		5,577,959	11/26/96	Takemoto et al.	463	25

<u>Exam Init</u>	<u>Ref</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>	<u>Class</u>	<u>Sub- Class</u>
		5,580,310	12/3/96	Orus et al.	463	16
		5,674,128	10/7/97	Holch et al.	463	42
		5,702,304	12/30/97	Acres et al.	463	29
		5,741,183	4/21/98	Acres et al.	463	42
		5,743,523	4/28/98	Kelly et al.	273	138.1
		5,752,882	5/19/98	Acres et al.	463	42
		5,758,875	6/2/98	Giacalone, Jr.	273	143 R
		5,761,647	6/2/98	Boushy	705	10
		5,811,772	9/22/98	Lucero	235	380
		5,816,917	10/6/98	Kelmer et al.	463	16
		5,816,918	10/6/98	Kelly et al.	463	16
		5,820,459	10/13/98	Acres et al.	463	25
		5,833,540	11/10/98	Miodunski et al.	463	42
		5,836,817	11/17/98	Acres et al.	463	26
		5,839,956	11/24/98	Takemoto	463	25
		5,854,542	12/29/98	Forbes	315	291
		5,902,983	5/11/99	Crevelt et al.	235	380
		5,919,091	7/6/99	Bell et al.	463	25
		6,048,269	4/11/00	Burns et al.	463	25

FOREIGN PATENT DOCUMENTS

<u>Application Number</u>	<u>Date</u>	<u>Filing Date</u>	<u>Inventor</u>
GB 2 211 975 A	7/12/89	11/3/87	McArthur

<u>Application Number</u>	<u>Date</u>	<u>Filing Date</u>	<u>Inventor</u>
AU B 27572/84	11/8/84	5/1/84	Harlick
AU B 53370/86	8/14/86	2/7/86	Frankovic
AU B 71194/91	8/22/91	2/19/91	Hilgendorf et al.
AU B 20986/92	1/28/93	8/12/92	Bennett
AU A 48323/97	6/25/98	12/11/97	Costello
WO 95/22811	8/24/95	2/21/95	Piechowiak et al.
WO 98/35309	8/13/98	2/10/98	Muir
WO 98/40140	9/17/98	3/10/98	Muir

OTHER DOCUMENTS

- Exam
Init Ref (Including Author, Title, Date, Pertinent Pages, Etc.)

Reference documents listed below are incorporated by reference from copending application no. 08/922,046, filed September 2, 1997, and assigned to the assignee of the present application ('046 application) as indicated in the accompanying Information Disclosure Statement.

Volume IX

- Deposition of Derell M. Jones and Exhibits 618, 619 & 620
- Deposition of John F. Acres and Exhibits 706 (color copies), 709 & 715
- Acres' Reponses to CDS' Proposed Findings of Fact Regarding CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 [On-Sale Bar] [Filed *Under Seal* – Subject to Protective Order]
- CDS' Reply Memorandum in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]

<u>Exam</u>	<u>Init</u>	<u>Ref</u>	<u>(Including Author, Title, Date, Pertinent Pages, Etc.)</u>
			Acres Gaming's Opposition to CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			Acres' Responses to Proposed Findings of Fact of Casino Data Systems Regarding CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			CDS' Reply Memorandum in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			Proposed Findings of Fact in Support of CDS' Memorandum of Points and Authorities in Support of CDS' Third Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			CDS' Motion and Memorandum of Point and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			Acres Gaming's Opposition to CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			Exhibits in Support of CDS' Memorandum of Point and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed <i>Under Seal</i> – Subject to Protective Order]
			January 1993 Product Catalog (Mikohn)
			1989 Mikohn Super Controller Manual

Examiner: _____

Date Considered: _____

RECEIVED

JUL 28 2000

TECHNOLOGY CENTER 3700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REISSUE LITIGATION
REISSUE PATENT APPLICATION
ATTORNEY DO. NO. 4164-133

Inventor(s): John F. Acres et al.

Original Patent No.: 5,655,961

Original Patent Issue Date: August 12, 1997

Title: METHOD FOR OPERATING NETWORKED GAMING DEVICES

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

This Information Disclosure Statement is submitted:

[X] under 37 CFR 1.97 (b), or

(Within three months of filing national application; or date of entry of International application; or before mailing date of first office action on the merits; whichever occurs last)

[] under 37 CFR 1.97 (c) together with either a:

[] Statement under 37 CFR 1.97 (e), or

[] a \$240 fee under 37 CFR 1.17 (p), or

(After mailing of first Office Action, but prior to Notice of Allowance or Final Office Action)

[] under 37 CFR 1.97 (d) together with either:

[] Statement under 37 CFR 1.97 (e),

[] Applicant hereby petitions for the consideration of the accompanying information disclosure statement (37 C.F.R. §1.97(d)(ii)).

[] a \$130.00 petition fee set forth in 37 CFR 1.17 (i)(1).

(Filed after final action or notice of allowance, whichever occurs first, but before payment of the issue fee)

[x] Applicant(s) submit herewith Form PTO 1449- Information Disclosure Citation together with copies of patents and publications of which applicant(s) are aware, which applicant(s) believe(s) may be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR 1.56. As set forth in the attachment to this IDS, some materials listed on the Form 1449 are incorporated by reference. Copies of documents cited that are not incorporated by reference are enclosed.

It is requested that the information disclosed herein be made of record in this application.

Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

MARGER, JOHNSON & McCOLLOM, P.C.
1030 S.W. Morrison Street
Portland, Oregon 97205
(503) 222-3613

Respectfully submitted,


Alan T. McCollom
Registration No. 28,881